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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,070	11/24/2000	Brian S. Kelleher	18608002910	3576

30328 7590 10/21/2003

NU VASIVE, INC.
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SAN DIEGO, CA 92131

EXAMINER

DOERRLER, WILLIAM CHARLES

ART UNIT	PAPER NUMBER
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3744

DATE MAILED: 10/21/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,070

Applicant(s)

KELLEHER ET AL.

Examiner

William C Doerler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15,16,22-26 and 30-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15,16,22-26 and 30-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

The corrected or substitute drawings were received on 5-29-2001. These drawings are acceptable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15,16,22-26,30,31 and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al '331 in view of Feler et al.

Raymond et al '331 discloses applicants' basic inventive concept, a method for determining the location of a nerve by electrically signaling the nerve and detecting the response and determining when the signal is below a threshold signifying close

proximity to the nerve (see abstract) and using a visual or audible alarm to signal the proximity to the nerve, substantially as claimed with the exception of using the process on a spinal nerve. While this is seen as a matter of design choice since all the nerves in a body function on the same principle, Feler et al nevertheless shows electrically determining the location of spinal nerves to be known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of Feler et al to modify the detection system of Raymond et al '331 by enabling the use for spinal nerves to enable safe operations in the vicinity of the spinal cord.

Claims 15,16,22-26,30,31 and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al '153 or 154 in view of Feler et al.

Raymond et al '153 and 154 each disclose applicants' basic inventive concept, a method for determining the location of a nerve by electrically signaling the nerve and detecting the response and determining when the signal is below a threshold signifying close proximity to the nerve (see column 3 lines 21-55) and using a visual or audible alarm to signal the proximity to the nerve(column 7 lines 3-23), substantially as claimed with the exception of using the process on a spinal nerve. While this is seen as a matter of design choice since all the nerves in a body function on the same principle, Feler et al nevertheless shows electrically determining the location of spinal nerves to be known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of Feler et al to modify the detection system of Raymond et al '153 or 154 by enabling the use for spinal nerves to enable safe operations in the vicinity of the spinal cord.

Claims 15,16,22-26,30,32,33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hadzic et al in view of Feler et al.

Hadzic et al discloses applicants' basic inventive concept, a method for determining the location of a nerve by electrically signaling the nerve and detecting the response and determining when the signal is below a threshold signifying close proximity to the nerve (see column 2 lines 1-14) and using a visual means to signal the proximity to the nerve, substantially as claimed with the exception of using the process on a spinal nerve.

While this is seen as a matter of design choice since all the nerves in a body function on the same principle, Feler et al nevertheless shows electrically determining the location of spinal nerves to be known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of Feler et al to modify the detection system of Hadzic et al by enabling the use for spinal nerves to enable safe operations in the vicinity of the spinal cord.

Response to Arguments

Applicant's arguments filed 10-6-2003 have been fully considered but they are not persuasive. Applicant has stated that none of the references state that the probe is introduced from the lateral direction. It is unclear how the probe can approach the nerve any other way. If the nerve is not approached from the side, the probe has already intersected the nerve. Treating the nerve like a line, the only approach possible is laterally, since above and below a given point of the line is more points on the line. None of the references state that the nerve is detected by moving a probe other than laterally. All the references are silent as to the direction of approach. It is considered

inherent that an ordinary practitioner in the art would approach the nerve from a lateral direction, since to do otherwise does not make sense. To do otherwise means that the nerve has already been sensed by the probe if not severed. It is noted that Hadzic et al and Raymond et al show the probe approaching the nerve laterally.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C Doerrler whose telephone number is (703) 308-0696. The examiner can normally be reached on Monday-Friday 6:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Esquivel can be reached on (703) 308-2597. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.


William C Doerrler
Primary Examiner
Art Unit 3744

WCD
October 20, 2003